

BS



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,987	01/11/2001	Marc De Beuckelcer	514412-2025	2496
20999	7590	11/09/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			SITTON, JEHANNE SOUAYA	
			ART UNIT	PAPER NUMBER

1634

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/758,987	BEUCKELEER, MARC DE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jehanne S Sitton	1634	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-31 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-31 and 34 is/are allowed.
- 6) ☒ Claim(s) 35 is/are rejected.
- 7) ☒ Claim(s) 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Currently, claims 29-31 and 34-36 are pending in the instant application and under consideration at this time. All the amendments and arguments have been thoroughly reviewed but are deemed insufficient to place this application in condition for allowance. The following rejections are newly applied, necessitated by amendment. They constitute the complete set being presently applied to the instant Application. Response to Applicant's arguments follow. This action is FINAL.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The rejection of claims 29-31 and 34 made at section 3 of the previous office action is withdrawn in view of the amendments to the claims as well as applicant's arguments made at page 5, 3<sup>rd</sup> full para of the response filed 9/3/2004. The claims have been amended to recite that the DNA sequences encompassed by the claims contain plant DNA as well as foreign DNA which define the elite event GAT-ZM1. Applicant's arguments that while corn plants possess genetic variability, any corn variety comprising elite event GAT-ZM1 would still contain the same nucleotide sequence as GAT-ZM1, including the immediate flanking sequences are persuasive as the claims recite the sequences immediately flanking the foreign DNA.

4. The rejection of claims 29-31 and 34 made at section 6 of the previous office action is withdrawn in view of the amendments to the claims.

***New Grounds of Rejection***

***Claim Rejections - 35 USC § 112***

5. Claim 35 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a NEW MATTER Rejection.

Claim 35 encompasses an isolated DNA molecule that comprises a sequence consisting of positions 286-487 of SEQ ID NO: 6, as well as molecules that comprise larger contiguous fragments which include positions 286-487 of SEQ ID NO: 6. The response states that the support for this amendment can be found throughout the specification, however the examiner was unable to find support for DNA molecules that comprise positions 286-487 of SEQ ID NO: 6 or molecules that comprise larger contiguous fragments which include positions 286-487 of SEQ ID NO: 6. The specification provides support for the fragment of position 286-487 of SEQ ID NO: 6, as well as the use of primers in the foreign and plant DNA of SEQ ID NOS 6 or 10 to produce fragments. The specification does not provide support for the scope of the molecules encompassed by the claims however. Accordingly, the recitation in section (i) of claim 35 introduces new matter into the claimed invention. Claim 35 would be allowable if this new matter were deleted. It is suggested that claim 35 be amended to recite "An isolated DNA molecule comprising the nucleotide sequence of SEQ ID NO: 6 or the nucleotide sequence of SEQ ID NO: 10".

Art Unit: 1634

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Brennan (US Patent 5,474,796).

Claim 35 has been broadly interpreted to encompass a nucleic acid molecule of any length which has a nucleotide a first nucleotide from any of positions 1-286 of SEQ ID NO: 6, and has a last nucleotide from any of positions 487-1041. The claim does not limit the sequences between the first and last nucleotide of the claimed molecule. Any trimer nucleic acid molecule, as taught by Brennan (see Fig 1), is encompassed by such claim recitation.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1634

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Claims 29, 30, 31, and 34 are free of the prior art and allowable. Claim 36 is objected to for being dependent on a rejected claim. Claim 35 is rejected under 35 USC 112, first para.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Sitton whose telephone number is (571) 272-0752. The examiner can normally be reached Monday-Thursday from 8:00 AM to 5:00 PM and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (571) 272-0745. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Jehanne Sitton  
Primary Examiner  
Art Unit 1634

*Jehanne Sitton*  
*11/5/04*